



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,203	05/14/2001	Lee A. Chase	LII150B US	9946
21133	7590	04/08/2004		EXAMINER
VAN OPHEM & VANOPHEM, PC				JOHNSTONE, ADRIENNE C
51543 VAN DYKE				
SUITE 103			ART UNIT	PAPER NUMBER
SHELBY TOWNSHIP, MI 48317-4447			1733	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/855,203	CHASE ET AL. <i>ed</i>
Examiner	Art Unit	
Adrienne C. Johnstone	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9-33 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 33 is/are rejected.
- 7) Claim(s) 9-25 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 May 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>111003</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I w/ linking Group IV, claims 9-25 and 33 in the amendment filed November 10, 2003 is acknowledged. The traversal is on the ground(s) that there is no serious burden; the inventions are not both independent and distinct, and that the apparatus is required to perform the claimed method . This is not found persuasive because the restriction requirement clearly set forth the different classifications of the different groups, which establishes *prima facie* serious burden not yet rebutted by applicants with the required showings or evidence (MPEP 808.02); Office policy has long interpreted the statute to require the inventions be independent *or* distinct as clearly set forth in MPEP 802.01; and the method limitations in the apparatus claim are merely intended use and do not in fact require the method steps to be performed by the apparatus (MPEP 2114). Of course, if linking claim 33 is found to be allowable, the examiner will rejoin the other group of process claims encompassed by the linking claim.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 26-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the amendment filed November 10, 2003.

Drawings

3. The drawings were received on May 14, 2001. These drawings are acceptable.

Specification

4. The disclosure is objected to because of the following informalities: in the continuing data in the first line of the specification applicants should update the status of parent application 09/184,190.

Appropriate correction is required.

Claim Objections

5. Claims 9-25 are objected to because of the following informalities: claim 9 line 32, the period should be changed to a semicolon for proper claim form (misleading period in the middle of the claim). Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot readily find support in the original disclosure for new generic claim 33 (for example reciting engaging “at least one nest”), and applicants did not specifically point out support for the new claim subject matter (see MPEP 714.02 and 2163.06).

Allowable Subject Matter

7. Claims 9-25 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose or suggest applicants' process for permanently attaching an overlay to a wheel, including using the particular apparatus including the fixture, pallet, and nests to perform the method steps, in the claimed environment.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571)272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:000PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone

April 5, 2004

